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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,256	01/18/2001	Trevor Smith	BSE 301	8276
23581	7590	04/29/2004	EXAMINER	
KOLISCH HARTWELL, P.C. 520 S.W. YAMHILL STREET SUITE 200 PORTLAND, OR 97204			FERNSTROM, KURT	
			ART UNIT	PAPER NUMBER
			3712	

DATE MAILED: 04/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/766,256

Applicant(s)

SMITH, TREVOR

Examiner

Kurt Fernstrom

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a generalized method of creating a program, and contain numerous examples of method steps which are taken by various third parties, including the managing board, the sponsors, and the students. Method claims which include steps which are intended to be performed by various entities are not patentable. Also, the invention is not within the technological arts.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Numerous method steps described in the

aforementioned claims, including production of a television show, production of a magazine, production of a computer-network based program, "training volunteers to coach students" and "applying inventive skills to develop new products" are not adequately described in the specification so as to enable one skilled in the relevant art to perform the method. In particular, the production of a computer program does not appear to be disclosed in the specification at all. Rather, the use of a computer-network based program is disclosed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention:

Claims 1 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with terminology whose scope is unclear, rendering the claims indefinite. While the instances of indefinite language are too numerous to list each one, the following examples are provided as a guide to assist the applicant in preparing a response. The phrases "coordination of acquiring funds", "encouraging the students in connection with the activity to purchase goods or services," "recruiting a plurality of volunteers", "training the volunteers," "intellectual activity," and "apply inventive thinking skills in a business setting to develop new products" are all vague and indefinite and do not define the scope of the claims. For example, what concrete method step is defined by "encouraging" or "training" someone to do something? What is considered to be "inventive thinking skills"?

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carmarthenshire Youth & Children's Association ("CYCA") in view of SJ Barons Pro Soccer ("Barons"), and further in view of HIV/AIDS Ministries Network - Focus Paper #28 ("HIV/AIDS"), Youth Communications and The Militant. It is well known to provide a board to manage a program including a youth club which provides various physical and intellectual activities to youth. CYCA discloses on such example of a youth club founded in 1981, which is managed by a board of trustees. Boards of trustees inherently perform such tasks as fund raising and management and recruitment and training of volunteers. Each of these steps is disclosed by CYCA. CYCA fails to disclose that the funding includes a sponsor which gives discounts to members of the group. It is well known that various clubs are commonly sponsored by business organizations. Barons discloses one such example, in the "Affiliated Club Programs" section, of a business organization which sponsors affiliated clubs and provides tickets to sporting events and other discounts to various services. FA further sponsor relationship is disclosed whereby uniforms can be purchased at a discount through the sponsor, where said purchase is inherently encouraged through the discount. While the

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step of donating a portion of sales revenues to the club is not explicitly disclosed, Official Notice is taken that it is common for business organizations to donate a portion of sales revenues to one or more charitable organizations. It would have been obvious to modify the method disclosed by CYCA by providing a sponsor which offers goods at a discount to club members and donates a portion of sales to the club for the purpose of providing an additional revenue source to the club. Applicant has further acknowledged on page 8 line 10 to page 9, line 7 of the specification that it is known to provide a program of providing mentors to student inventors to aid them in developing new products, as claimed in claim 13. It would have been obvious to modify the method disclosed by CYCA by providing mentors to guide students in developing new products for the purpose of instructing students how to develop a product in a business setting.

CYCA and Barons fail to disclose the production of a television show. HIV/AIDS discloses on page 5 a method of providing AIDS education to teens comprising the step of producing a television show. It would have been obvious to modify the method disclosed by CYCA as viewed in combination with Barons by providing the step of producing a television show for the purpose of allowing members to learn the various tasks associated with production of a television show, and for the purpose of learning about various subjects in a creative environment.

CYCA further fails to disclose the production of a magazine. Magazines produced by youth groups are well known. Youth Communications discloses two examples of magazines produced by youth groups. It would have been obvious to modify the method disclosed by CYCA as viewed in combination with Barons by

providing the step of producing a magazine for the purpose of allowing members to learn the various tasks associated with production of a magazine, and for the purpose of communicating ideas to a larger group of people.

CYCA further fails to disclose the production of a computer program. The Militant discloses in paragraph 2 of page 1 a method of managing a youth club comprising the step of producing a computer-network based program. It would have been obvious to modify the method disclosed by CYCA by providing the step of producing a computer program for the purpose of allowing members of various affiliated clubs to share information over a network.

CYCA further fails to disclose a board of advisers. Boards of advisers are a well known feature of various organizations. Youth Communications discloses on page 3 a program comprising a board of advisers, where the members have expertise in various areas such as magazine production and community relations. It would have been obvious to modify the method disclosed by CYCA by providing a board of advisers for the purpose of providing advice given by people who have expertise in various areas.

### ***Response to Arguments***

Applicant's arguments filed on February 5, 2004 have been fully considered but they are not persuasive. The rejections under 101 and 112 are maintained, for the reasons set forth above and in prior office actions.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections

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are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The test for obviousness is not whether a single reference discloses or suggests all of the limitations of the claims. Rather, the test is whether the prior art, viewed as a whole, suggests the claimed invention. In this case, each of the limitations in the claims is disclosed or suggested by the prior art when viewed as a whole. Further, the references are all analogous art, as they are each drawn to youth programs. In addition, the motivation to provide each element is disclosed by the respective references. The claimed invention is obvious over the cited prior art.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.




Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KF  
April 27, 2004

  
Kurt Fernstrom